Paper No. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEIJI KITAGAWA,
and IKUO TANI

Appeal No. 2002-0641
Application No. 09/407,069

HEARD: August 19, 2003

Before KRASS, JERRY SMITH, and RUGGIERO Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 19-22 and 33-43, all of the pending claims.

The invention is directed to automatically opening one of a plurality of specialized drawing programs by merely clicking on a graphic form on a display, without taking any other steps.

Representative independent claim 19 is reproduced as follows:

19. A graphic data processing apparatus comprising:

means for storing containing a plurality of different graphic data programs, each different program for creating graphic data for a different respective data type only, wherein the created graphic data includes a data type and attributes data therefor, with each different graphic data program having an individual set of attribute items therefor;

graphic data storing means for storing graphic data including different data types and attributes data therefor;

means for displaying at least one graphic form based on the graphic data;

means for designating a graphic for displayed on said displaying means;

means for selecting one of the graphic data programs from said graphic data programs storing means in accordance with a data type corresponding to the graphic form designated by the graphic form designating means; and

means for configuring said apparatus to activate said graphic data program selected by said selecting means to create graphic data to display the graphic form of a same kind as the graphic form designated by said designating means on said displaying means.

The examiner relies on the following reference:

Yoshida	4,747,074	May 24, 1988

Claims 19-22 and 33-43 stand rejected under 35 U.S.C. §103 as unpatentable over Yoshida.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

At the outset, we note that this case is a continuation of Application Serial No. 08/858,809, and a decision (Appeal No. 2003-0724) on appeal has been made in the parent case.

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v, John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason much stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc. , 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In

re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR 1.192 (a)].

As to claims 19-22 and 33, in Yoshida, the examiner points to a first storage means, command register CR, for storing a plurality of graphic data programs. The examiner cites column 1, lines 31-36, and column 2, lines 31-38, of Yoshida for the recitation of "drawing command." The examiner further points to column 2, lines 39-46, for a teaching of each program creating graphic data (displaying graphic forms) for a different graphic data type, and to column 2, lines 54-57, for a teaching of the created graphic data including a data type and attribute data therefor. A second storage means AR is said to be read and written to by a CPU for storing graphic data of the displayed graphic forms (column 3, lines 31-57) and a means for displaying graphic forms based on the graphic data is said to be taught at column 4, lines 19-23, and Figure 2. A means for designating one of the graphic forms is said to be taught at column 4, lines 39-44, and a means for extracting a drawing program associated with the designated graphic form for editing operations is said to be taught at column 4, lines 24-31 and 60-63). Editing operations, including drawing correction, delete and scaling, is said to be taught at column 1, lines 33-36 and column 4, lines 26-31. The examiner further explains that "[s]ince the extracted drawing program is same [sic] the program that created the designated graphic form, which program includes a command code for drawing basic pattern

and operation mode (col. 2, lines 39-57), it is capable of re-creating a graphic form of the same kind as the deleted graphic form" (Paper No. 28, pages 2-3).

It is the examiner's position that while Yoshida fails to explicitly teach that the editing operations include creating a graphic form of the same kind, it does suggest that the edit operations may include a scale operation which includes deleting the graphic form and creating another graphic form of different size. Accordingly, contends the examiner, it would have been obvious to implement a scale operation to Yoshida's edit operations.

We find the examiner has failed to present a case of prima facie obviousness because, contrary to the examiner's position, we find nothing in Yoshida corresponding to the instant claimed graphic data "programs," a plurality of different such programs being stored and each different program for creating graphic data for a different respective data type only.

The examiner relies on Yoshida's disclosure of a "drawing command" as corresponding to the claimed "program." However, while Yoshida describes a "drawing command" in the background section of the patent as "consisting of a program instruction which relates to a specific graphic form to be drawn," there is no indication that the drawing command itself is a graphic data program, or that a plurality of different such programs are employed, although a plurality of drawing commands is stored, column 2, lines 34-35. Moreover, a reading of the Yoshida disclosure makes it clear that a display controller has a function of facilitating extraction of a specific command for a drawing part of a graphic form from among a command group for drawing graphic forms and that in order for Yoshida to correct a graphic form, it is necessary to delete the graphic form to correct the

displayed picture. Since it becomes necessary to extract and delete a drawing command in order for a correction to occur, if the examiner is implying that Yoshida's extraction operation is tantamount to selection of a program, as claimed, then it would appear that Yoshida would be deleting the drawing program itself. If the drawing program is deleted, then how can Yoshida's system operate? Accordingly, it would appear that Yoshida's disclosure would foreclose the possibility that the "drawing command" disclosed therein can be a graphic data program, as is recited in the instant claims.

Since we find that the "drawing command" of Yoshida cannot be the claimed "graphic data program," and each of the instant claims requires at least such a program, or a plurality thereof, we will not sustain the rejection of any of claims 19-22 and 33-43 under 35 U.S.C. §103.

The examiner's decision is reversed.

REVERSED

ERROL A. KRASS Administrative Patent Judge	)))))) BOARD OF PATENT
JERRY SMITH Administrative Patent Judge	) APPEALS) AND) INTERFERENCES
JOSEPH F. RUGGIERO Administrative Patent Judge	))))

EAK/lp

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007